

Appl. No. 09/812,417
Amdt. Dated 05/10/2004
Reply to Office Action of 03/09/2004

REMARKS/ARGUMENTS

This Amendment is in response to the Office Action mailed 03/09/2004. In the Office Action, claims 1-28 were rejected under 35 U.S.C. § 102. Reconsideration in light of the remarks made herein is respectfully requested.

Claims 1-28 remain in this application.

Rejection Under 35 U.S.C. § 102

1. Claims 1-28 were rejected under 35 U.S.C. § 102(b) as being anticipated by Davis et al. (US Patent No. 5,822,123). Applicants respectfully traverse the rejection and contend that a *prima facie* case of anticipation has not been established.

As the Examiner is aware, to anticipate a claim, the reference must teach every element of a the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Vergegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the...claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ 2d 1913, 1920 (Fed. Cir. 1989).

The Office Action states, on Page 5, paragraph 3, beginning on line 5 to the end of the first paragraph on page 7, line 4, that the limitations set forth to rely upon "[w]hen the user first enters the BROWSE mode ...which asks the user if she would like to tune to the selected program." (Davis, Col. 16, lines 4-66). The Office Action, however, does not specifically argue how the excerpt shows that Davis discloses, teaches, or suggests "at least one future program action being selected by the user" as recited in claims 1, 9, 17, 23.

At most, Davis merely discloses "the system will display future program schedule information for the particular channel previously selected by the up and down direction arrows" (Davis, Col. 16, lines 10-12), or "[s]uch highlighted information reminds the user that he is viewing program schedule information for a future time" (Davis, col. 16, lines 29-30), or "[a] REMINDER message queries the user as to whether the system should remind the user.."(Davis,

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Col. 16, lines 45-49), or "[a] REMINDER message also displays a "TUNE" inquiry, which asks the user if she would like to tune to the selected program." (Davis, Col. 16, lines 65-67).

None of the above teachings in Davis corresponds to a future program action being selected by the user. The future program schedule information is not a future program action. The future program schedule information merely contains the time at which a particular program is shown (Davis, Figures 18-21). A reminder message merely reminds the user of a future program to be viewed. In contrast, a future program action is an action that affects the future program (See, for example, specification, paragraph [0038]). By providing a future program action, the claimed invention offers an advantage over the prior art reference in that a selected action will be performed on a future program, rather than just displaying a program schedule information, or reminding the user of tuning to a selected program.

The Office Action further states, on page 7, paragraph 3, lines 8-18, that the limitations as claimed set forth to rely upon "[t]he pop-up hints concept . . . whether or not the screen indicator is over an on-screen control" (Davis, Col. 39, lines 59-67; Col. 40, lines 1-7). Again, the Office Action does not show that the excerpt discloses, teaches, or suggests "displaying the future program information of the selected at least one future program with an indicator such that the indicator indicates the selected at least one future program action" as recited in claims 1, 9, 17, and 23.

At most, Davis merely discloses "the system ...informing the user of his or her options whether or not the screen indicator is over an on-screen control." (Davis, col. 40, lines 5-7). The screen indicator is moved by the user manipulating a mouse to select the on-screen control (Davis, col. 40, lines 1-3). The on-screen control functions merely refer to controlling of a button or a modifier key such as "click a button, "hold down the Alt key", etc. (Davis, col. 39, lines 66-67; col. 40, lines 49-53). This screen indicator, therefore, does not indicate the selected at least one future program action. By providing an indicator that indicates the selected program action, the claimed invention offers an advantage over the prior art reference in that it allows the user to add, cancel, or modify actions on future program as desired, rather than just controlling a button or a modifier key.

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Applicants respectfully submit that Davis does not disclose or suggest (1) providing a future program information for a plurality of future programs, at least one future program being selected by a user; (2) providing on a future program actions menu, a plurality of future program actions for the selected future program, at least one future program action being selected by the user; (3) receiving the selected at least one future program and the selected at least one future program action from the user; or (4) displaying the future program information of the selected at least one future program with an indicator such that the indicator indicates the selected at least one future program action as recited in claims 1, 9, 17, and 23.

"In order to provide a complete application file history and to enhance the clarity of the prosecution history record, an examiner must provide clear explanations of all actions taken by the examiner during prosecution of an application." See MPEP 707.07(f). Here, the Office Action does not provide clear explanations of the actions. The Office Action merely recites paragraphs in the prior art reference and concludes that the claim limitations read broadly on Davis.

Furthermore, "[w]here the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it." See MPEP 707.07(f). As argued in the previous response, the highlighted information or a viewing reminder is not a future program action which acts upon a future program. The Office Action, however, does not address the substance of this argument regarding the program action.

Accordingly, Applicants respectfully request that the Examiner withdraw the 35 U.S.C. § 102(b) rejection.

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Conclusion

Applicants respectfully request that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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